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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/943,372	08/30/2001	Cheryl Sott		9074

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EXAMINER

WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 06/04/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/943,372

Applicant(s)

SOTT, CHERYL

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 14, 15 and 26-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 14, 15, 26-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 5.
2. Applicant's election of invention group I in Paper No. 5 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Applicants' election of species with traverse is acknowledged. The traverse is persuasive, and, therefore, the species election requirement is herein withdrawn. Particularly, the elected invention is drawn to method of selecting and formulating essential oil, limitation to particular essential oil is improper.

Claim Rejections 35 U.S.C. 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-13, 16-25 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for particular personal preferences which could be directly linked to particular essential oil, does not reasonably provide enablement for the "analysis," "value" and correlation ship between the "value" and essential oil. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims. Note the analysis and calculation of "value" may encompass anything that might be relevant to human.

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The instant claims are drawn to a method comprising steps of: a) performing an analysis of an individual; b) calculating a value from the analysis; c) co-relating the value to particular essential oils; and selecting essential oil based on the results; ...etc. The specification or the claims does not provide sufficient guidance, direction and working example to enable a skilled artisan to fully understand the meanings of “analysis,” “calculating,” and the “value” herein, and to perform the claimed invention without undue experimentation.

5. The instant specification fails to provide information that would allow the skilled artisan to practice the instant invention without undue experimentation. Attention is directed to *In re Wands*, 8 USPQ 2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factor to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApl 1986) at 547 the court recited eight factors:

- 1) the quantity of experimentation necessary,
- 2) the amount of direction or guidance provided,
- 3) the presence of absence of working examples,
- 4) the nature of the invention,
- 5) the state of the prior art,
- 6) the relative skill of those in the art,
- 7) the predictability of the art, and
- 8) the breadth of the claims.

The instant claims are drawn to a method comprising steps of: a) performing an analysis of an individual; b) calculating a value from the analysis; c) co-relating the value to particular essential

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oils; and selecting essential oil based on the results; ...etc. However, the specification or the claims fails to make proper written description with respect to how to carry out such steps. More specifically, the specification of the claims does not provide sufficient guidance, direction, and working examples for the steps comprised in claimed method. For example, there is no clear guidance or direction as to how to do the analysis, calculation, and correlating the obtained "value" to essential oil. One of ordinary skill in the art would have not been able to carry out the steps of a) performing an analysis of an individual; b) calculating a value from the analysis; c) co-relating the value to particular essential oils; and selecting essential oil based on the results. Note the Applicants fail to provide information allowing skilled artisan to ascertain these steps without undue experimentation.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-13 and 16-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims, recites "analysis," "calculating," and "value," "preference analysis," and "personality analysis," however, the specification or the claims fails to give them clear definitions. The claims are indefinite as to the meanings of the phrases cited herein. Note, each of the above phrases may have multiple meanings depending on circumstance.

Claim Rejections 35 U.S.C. 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-13 and 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rigg et al. (US 5,622,692), in view of Meador et al. (US 5,031,764)

11. The claimed invention has been broadly interpreted as a method of formulating customized cosmetic product based on the information from the customer. Rigg et al. teaches a method of making customized cosmetic product based on the information obtained from customer. See, particularly, the abstract, and the claims.

12. Rigg does not teach expressly to customize the ingredient of essential oils, or the particular steps herein.

13. However, Meador teaches that method of customizing fragrance based on customer's preference is known in the art. See, particularly, columns 1-3.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ the method of Rigg for customizing essential oil composition in a cosmetic product based on customer's preference.

A person of ordinary skill in the art would have been motivated to employ the method of Rigg for customizing essential oil composition in a cosmetic product based on customer's preference because such method would have provide customized product. One of ordinary skill in the art would have been reasonably expected to be able to make a customized essential oil composition since such method is known in the art. The optimization of a result effective parameter, e.g., the detailed steps of a known procedure, is considered within the skill of the artisan. See, In re Boesch and Slaney (CCPA) 204 USPQ 215. Furthermore. Employment of a customized

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fragrance composition in various well-known cosmetic forms recited herein is considered within the skill of artisan and is obvious.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Patent Examiner
SHENGJUN WANG
PATENT EXAMINER

Shengjun Wang

May 24, 2003